



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patricia Lewis  
#15 Appeal  
Brief  
9-14-02

Application of:  
SLOO, MARSHALL A. )  
Serial No.: 09/259,427 ) Docket No.: 27080  
Filed: February 26, 1999 ) Group Art Unit No.: 3628  
Title:  
INCIDENT REPORTING SYSTEM ) Examiner: Nguyen, Nga B.  
AND METHOD )

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**APPEAL BRIEF**

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GROUP 3600



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Assistant Commissioner of Patents  
Washington, D.C. 20231

APPLICANT'S BRIEF ON APPEAL

In response to the Advisory Action dated May 22, 2002, Applicant's Brief on Appeal in accordance with 37 C.F.R. §1.192 is hereby submitted, in triplicate. The Examiner's rejections of the claims as last amended are herein appealed and allowance of said claims is respectfully requested.

The requisite fee of \$160.00 as required by 37 C.F.R. §1.17(c) is submitted herewith. Any additional fee which is due in connection with this appeal should be applied against Deposit Account No. 19-0522.

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Respectfully submitted,

By

50,576

FOR

**GROUP 3600**

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Following are the requisite statements under 37 C.F.R. §1.192:

**I. Real Parties in Interest**

Marshall A. Sloo is the sole inventor of the claimed invention and the real party in interest.

**II. Related Appeals and Interferences**

No related appeals or interferences are known to Appellant which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

The application, as originally filed, contained sixteen (16) claims, with claim 1 being the only independent claim.

A first Office action was mailed on September 25, 2001, rejecting claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,043,813 to Stickney, in view of Official Notice taken by the Examiner. In response, claim 1 was amended in order to highlight differences between the present invention and the prior art cited, supporting arguments were made, the Official Notice was traversed, and applicant requested proof of the Official Notice. Additionally, four (4) new claims, claims 17-20, were added, with claims 17 and 20 being independent.

A second Office action was mailed on March 12, 2002, rejecting claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,065,000 to Jensen, in view of Official Notice taken by the Examiner. The second Office action was made final.

In response, arguments were made highlighting differences in the claims and the prior art cited, the Official Notice was again traversed, and applicant again requested proof of the Official Notice.

An advisory action was mailed on May 22, 2002, responding to arguments regarding claims 1, 2, and 6-10. No mention was made of claims 3-5 and 11-20. In response, a Notice of Appeal was filed.

Claims 1-20 are currently pending and the rejections of these claims are appealed.

#### **IV. Status of Amendments**

All amendments submitted by the Appellant have been entered.

#### **V. Summary of the Invention**

The present invention concerns a computer based method and program for receiving, collecting, and processing incident reports provided by witnesses. See page 1, lines 31-33. The method broadly comprises the steps of receiving information directly from a witness who observed an incident committed by an offender, prompting the witness to enter certain types of information about the incident, selecting an authority based on the information entered by the witness, and sending the incident report to the selected authority so that the authority can respond to the incident report. The present invention encourages witnesses to submit incident reports because it does not require them to know or identify to whom the incident report should be sent. See page 2, lines 1-12. After the witness has entered information into the incident report, the authority to whom the incident

report should be sent is selected. The authority may be selected by the witness, automatically by the program, or a combination of the two. See page 6 lines 25-32. Thus, if the witness does not know who the appropriate authority is, the program may automatically select the authority based on the information entered by the witness. Additionally, if the witness requests to send the incident report to a particular authority, the program may evaluate the information entered by the witness and determine that the incident report should also be sent to another authority. See page 7, lines 2-8.

The present invention expressly identifies and seeks to address a particular problem in the prior art. Specifically, people often do not report incidents to the appropriate authority, making it difficult for the appropriate authority to act on the incidents.

Thus, it will be appreciated that the present invention's field of endeavor relates to a method of receiving incident reports provided by witnesses, selecting an appropriate authority based on information in the incident reports, and sending the incident reports to the appropriate authority so that they may be acted upon in an efficient and more convenient manner than is provided for by the prior art.

## **VI. Issues**

1. Whether the Examiner has properly produced references in support of Official Notice taken by the Examiner.
2. Whether the Examiner has established a *prima facie* case of obviousness as required by 35 U.S.C. §103.

## **VII. Grouping of Claims**

In accordance with 37 C.F.R. §1.192(c)(7), it shall be noted that the claims do not stand or fall together. Specifically, the appellant requests that claims 1-6, 8, 11-15 and 17 be grouped as Group 1, claims 7, 18, and 20 be grouped as Group 2, and claims and 9, 10, and 19 be grouped as Group 3. Arguments in support of the requested grouping can be found below.

## **VIII. Arguments and Authorities**

### **A. Arguments in support of the requested grouping.**

As discussed above, the appellant requests that claims 1-6, 8, 11-15 and 17 be grouped as Group 1, claims 7, 18, and 20 be grouped as Group 2, and claims and 9, 10, and 19 be grouped as Group 3. Thus, Group 1 consists of independent claims 1 and 17 and dependent claims 2-6, 8, and 11-15, which depend direct or indirectly from claim 1. Claim 1 recites “selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness”. Similarly, claim 17 recites “selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information entered by the witness”.

Therefore, Group 1 consists of claims directed to a computer-based method that includes selecting an appropriate authority based at least in part on information entered by a witness. As stated in response to the first Office action, the present invention allows the witness to prepare an incident report first. Then, based on the information supplied in

the incident report, select the appropriate authority. The witness is in a better position to select the appropriate authority with the incident report prepared and all known facts laid out. In the broadest sense of Group 1, anyone may select the appropriate authority, provided the appropriate authority is selected based upon information entered by the witness.

Group 2 consists of independent claim 20 and dependent claims 7 and 18, which depend direct or indirectly from claim 1 or 17, respectively. Claim 20 recites "selecting an authority to whom the incident report should be sent, wherein the authority is selected by the computer system based at least in part on information entered by the witness". Claim 7 recites "wherein the authority is automatically selected by the computer system based on information entered into the incident report by the witness". Similarly, claim 18 recites "wherein the authority is selected by the computer system based on information entered into the incident report by the witness".

Therefore, Group 2 consists of claims directed to a computer-based method utilizing a computer system that can analyze incident reports and select an appropriate authority based at least in part on information entered into the incident reports by a witness. Group 2 necessarily requires that the computer system posses more than mere message sharing capabilities. The computer system of Group 2 must actually analyze each incident report and select the appropriate authority to whom the incident report should be sent, based upon such analysis.

Group 3 consists of dependent claims 9, 10, and 19, which depend direct or indirectly from claim 1 or 17. Claim 9 recites "receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident

report". Claim 10 depends from claim 9. Claim 19 recites "receiving an action report from the authority explaining what action was taken in response to the incident report".

Therefore, Group 3 consists of claims directed to a computer-based method that receives action reports from an authority explaining action taken by the authority and prompted by the incident report. The authority of Group 2 must not only receive the incident report, but they must also take action in response to the incident report and provide the action report explaining the action taken.

Thus, Group 2 is significantly narrower than and would be patentable over Group 1, if Group 1 were to be used as a reference against Group 2. Similarly, Group 3 is significantly narrower than and would be patentable over Group 1, if Group 1 were to be used as a reference against Group 3. Additionally, both Group 2 and Group 3 would be patentable over each other, if either one were to be used as a reference against the other.

**B. The Examiner has improperly rejected claims 1-20 under 35 U.S.C. §103(a) by taking Official Notice and failing to provide proof of the official notice once traversed. Therefore, these rejections cannot be sustained.**

MPEP §2144.03 addresses reliance on common knowledge in the art and procedures for utilizing Official Notice. As stated therein, the rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. However,

if the applicant traverses such an assertion the Examiner should cite a reference in support of his or her position.

Furthermore, when a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2). This requirement clearly establishes the applicant's right to review and challenge the Examiner's assertions during pendency of the application.

See *In re Ahlert*, 165 USPQ 418, 420-421 (CCPA 1970) ("[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." Furthermore the applicant must be given the opportunity to challenge the correctness of such assertions and allegations. "The facts so noticed serve to 'fill the gaps' which might exist in the evidentiary showing" and should not comprise the principle evidence upon which a rejection is based.). Therefore, case law clearly supports applicant's right to review and challenge the Examiner's assertions. Case law also establishes that Official Notice may only be used to "fill in the gaps" and should not "comprise the principle evident upon which a rejection is based".

See *In re Chevenard*, 60 USPQ 239 (CCPA 1943) A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the

Examiner must be given the opportunity to provide evidence in the next Office action. Thus, the applicant clearly has a duty to traverse an Official Notice, with which there is disagreement. Additionally, when the applicant seasonably challenges such Official Notice, the Examiner must provide evidence in support of his or her position so that the applicant may review and, if necessary, challenge the Examiner's assertions. Thus, case law requires that the applicant be given the opportunity to challenge the correctness of the Examiner's assertions and allegations.

- a. *The Examiner did not provide proof in support of the Official Notice during prosecution. Therefore, the applicant was not "given the opportunity to challenge the correctness of such assertions".*

On page 3, count 4, of the Office action dated September 25, 2001, the Examiner acknowledged that "Stickney does not disclose selecting an authority to whom the incident report should be sent and sending the incident report to the selected authority". Additionally, the Examiner took Official Notice that "sending the information to the selected persons via such as electronic mail are well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features above with Stickney's for the purpose of sending the information to the selected persons". The Examiner cited no reference in support of the Official Notice.

In response, the applicant filed an Amendment traversing and requesting proof of the Official Notice. On page 6 of the Amendment, the applicant argued "the authority has already been selected long before the Stickney tool can be used. Therefore, not only does

Stickney not teach of selecting an authority, Stickney actually teaches away from there being more than one authority". Therefore, the applicant seasonably challenged the Official Notice and argued that the prior art does not teach or suggest "selecting an authority". Specifically, the prior art clearly does not teach or suggest selecting an authority based on information provided by the witness, as recited in Group 1.

On page 4, count 4, of the Office action dated September 25, 2001, the Examiner also acknowledged that "Stickney does not disclose the authority is automatically selected by the computer system based on information entered into the incident report by the witness". Additionally, the Examiner took Official Notice that "selecting the authority to send out the information by the computer system or by the person is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features above with Stickney's for the purpose of sending the information to the selected authority". The Examiner cited no reference in support of the Official Notice.

On page 6 of the Amendment, the applicant traversed and requested proof of the Official Notice. The applicant also argued that "Stickney's tool is not concerned with selecting an authority". Therefore, the applicant seasonably challenged the Official Notice and argued that the prior art does not teach or suggest the computer system selecting the authority.' Specifically, the prior art clearly does not teach or suggest the authority being selected by the computer system, as recited in Group 2.

On page 4, count 4, of the Office action dated September 25, 2001, the Examiner also acknowledged that "Stickney does not disclose receiving into the computer system an action report from the authority explaining the action the authority took in response to the

incident report". Additionally, the Examiner took Official Notice that "receiving into the computer system the information from the persons and storing the information in a file accessible by the computer system are well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features above with Stickney's for the purpose of storing the information received from the person in a file accessible by the computer system". The Examiner cited no reference in support of the Official Notice.

On page 7 of the Amendment, the applicant traversed and requested proof of the Official Notice. The applicant also argued that "[c]urrent methods require that an authority directly contact a witness in order to inform them of any action taken". Therefore, the applicant seasonably challenged the Official Notice and argued that the prior art does not teach or suggest "receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report". Specifically, the prior art clearly does not teach or suggest the computer system receiving the action report from the authority explaining the action the authority took in response to the incident report, as recited in Group 3.

Therefore, the Examiner rejected each Group taking Official Notice of "principal evidence" without citing references in support of the Official Notice. In each case, the applicant traversed and requested proof of the Official Notice, thereby meeting the applicant's burden. Additionally, the applicant presented arguments that the prior art does not teach or suggest the limitations of the present invention.

On page 3, count 6, of the Office action dated March 12, 2002, the Examiner acknowledged that "Jensen does not disclose the witness selects the authority to whom

the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness and sending the incident report to the selected authority so that the authority can respond to the incident report". Additionally, the Examiner took Official Notice that "selecting the person to whom the information should be sent based on the contain of the information and sending the information to the selected persons via such as electronic mail are old and well known in the art ... Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features above with Jensen's for the purpose of sending the information to the selected persons".

The Examiner cited an example of writing an email and then selecting to whom the email should be sent. However, this does not support the rejection, since an email author already knows to whom the email will be sent before they begin writing the email. Therefore, the email author does not "[select] an authority ... based at least in part on information provided by [a] witness". Thus, the Examiner cited no reference in support of the Official Notice.

In response, the applicant filed an Request for Reconsideration again traversing and requesting proof of the Official Notice. On page 2 of the Request for Reconsideration, the applicant argued that "[s]electing the authority is clearly done based upon information provided in the incident report". On page 3 of the Request for Reconsideration, the applicant argued that Jensen teaches of a report generator to fill out forms and that "the witness must first decide for which authority the incident report should be prepared. Then, the witness must select an appropriate form", all before the witness can begin entering information into the incident report. Clearly, Jensen teaches that the authority is selected

before the information has been entered into the incident report. Therefore, the applicant again seasonably challenged the Official Notice and argued that the prior art does not teach or suggest "selecting an authority ... based at least in part on information provided by the witness". Specifically, the prior art clearly does not teach or suggest selecting an authority based on information provided by the witness, as recited in Group 1.

On page 5, count 6, of the Office action dated March 12, 2002, the Examiner also acknowledged that "Jensen does not disclose the authority is automatically selected by the computer system based on information entered into the incident report by the witness". Additionally, the Examiner took Official Notice that "the computer system is automatically selecting the person or the data based on the information the user entered is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Jensen's for the purpose of sending the information to the person selected by the computer system. The Examiner cited no reference in support of the Official Notice.

On page 5 of the Request for Reconsideration, the applicant argued that "Jensen teaches of the witness making all decisions in this regard before providing information in the incident report. Therefore, this decision cannot possibly be made based upon the incident report, since the incident report does not exist at the time the decision is being made. Furthermore, Jensen does not teach of the computer system making any decisions, as Jensen's computer system is not capable of decision making". Therefore, the applicant again seasonably challenged the Official Notice and argued that the prior art does not teach or suggest the computer system selecting the authority "based at least in part on

information provided by the witness". Specifically, the prior art clearly does not teach or suggest the authority being selected by the computer system, as recited in Group 2.

Therefore, the Examiner again took Official Notice of "principal evidence" in rejecting both Group 1 and Group 2 without support. Since the Office action dated March 12, 2002 made the rejections final, the applicant was given no "opportunity to challenge the correctness of such assertions and allegations".

*b. Proof supposedly in support of the Official Notice and provided after final rejection does not support the Official Notice. Therefore, the Examiner has not cited a reference in support of his position.*

On page 2, count 3, of the advisory action dated May 22, 2002, the Examiner acknowledged that "Jensen does not disclose the witness selects an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness and sending the incident report to the selected authority so that the authority can respond to the incident report". Additionally, the Examiner took Official Notice that "selecting the person to whom the information should be sent based on the contain of the information and sending the information to the selected persons via such as electronic mail are old and well known in the art ... Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the features above with Jensen's for the purpose of sending the information to the selected persons".

The Examiner again cited an example of writing an email and then selecting to whom the email should be sent. However, this does not support the rejection, since an email author already knows to whom the email will be sent before they begin writing the email. Therefore, the email author does not “[select] an authority … based at least in part on information provided by [a] witness”.

The Examiner also cited Horovitz et al., U.S. Patent no. 5,812,759 with no explanation or specific references. The appellant has reviewed Horovitz. Horovitz teaches of a system where a message sender knows to whom a message should be sent, but may need help in deciding how and in what form to send the message. Horovitz does not teach or suggest “selecting an authority … based … on information provided by the witness”. Specifically, the prior art clearly does not teach or suggest selecting an authority based on information provided by the witness, as recited in Group 1.

On page 3, count 3, of the advisory action dated May 22, 2002, the Examiner acknowledged that “Jensen does not disclose the authority is automatically selected by the computer system based on information entered into the incident report by the witness”. Additionally, the Examiner took Official Notice that “the computer system is automatically selecting the person or the data based on the information the user entered is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Jensen’s for the purpose of sending the information to the person selected by the computer system”.

The Examiner cited Costin et al., U.S. Patent no. 6,178,413 with no explanation or specific references. The appellant has reviewed Costin. Costin teaches of a system that automatically creates pull down lists so that a user may make selections therefrom.

Specifically, as recited in column 5, lines 54-58, “[t]he user enters the list box information by selecting items from the list boxes … [t]hese items can include author of the document, the recipient of the document or …”. Clearly, Costin teaches that “[t]he user enters … the information by selecting … the recipient of the document”. Specifically, the prior art clearly does not teach or suggest the authority being selected by the computer system, as recited in Group 2.

Therefore, the Examiner has not cited references that support either Official Notice. The references cited do not teach or suggest the limitations of the present invention. Thus, rejections based on the Official Notices cannot be sustained.

**C. The Examiner has failed to establish a *prima facie* case of obviousness as required by 35 U.S.C. 103(b), specifically with regard to identifying a sufficient suggestion or motivation for combining the prior art references.**

The Examiner's rejection of claims 1-20 under 35 U.S.C. §103(a) is based on modification of a single prior art reference, Jensen. Specifically, the Examiner's rejections rely on two separate and compounded determinations of obviousness. According to the Examiner, the present invention is *obvious* in light of modification of Jensen wherein the suggestion or motivation for modifying Jensen is *obvious* given the knowledge of one with ordinary skill in the art. The Examiner's mere conclusory assertions of obviousness, without more, are not sufficient to establish a *prima facie* case of obviousness or to shift the burden to the applicant to refute, in this case, two negative propositions.

In rejecting the claims under 35 U.S.C. §103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). MPEP §706.02(j) addresses rejections under 35 U.S.C. §103 over prior art and sets forth three criteria that must be met in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. See MPEP §706.02(j), citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." See *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (reversing an obviousness rejection where there was no suggestion to modify prior art mower strip to make it entirely flexible as required by applicant's claims on a flexible landscape edging strip.); see also, *In re Gordon*, 221 U.S.P.Q.2d 1125, 1127 (Fed. Cir. 1984). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

In meeting this initial burden, however, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation

of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

Additionally, as stated in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

- a. *The Examiner has not identified a sufficient suggestion or motivation for modifying the prior art, and, therefore, has failed to establish a prima facie case of obviousness as required by 35 U.S.C. §103.*

On page 4, count 6, of the Office action dated March 12, 2002 and pages 2-3, count 3, of the advisory action dated May 22, 2002, the Examiner asserts that, "it would have been obvious to one with ordinary skill in the art to incorporate the features above with Jensen's for the purpose of sending information to the selected persons", with respect to Group 1. The Examiner is unable to find a suggestion or motivation in the cited prior art

references themselves because none exists. Instead, the Examiner is forced to rely on a mere conclusory assertion that the modification would be obvious given the knowledge of one with ordinary skill in the art. This argument, however, relies on a separate initial determination of obviousness (the suggestion or motivation to modify) to support a second determination of obviousness (the present invention from the modification). Obviousness assertions are always problematic as the Examiner has the benefit of a blueprint in the form of the specification of the invention, in which light even an exceedingly complex solution may seem easy or obvious. It is against exactly these facts that the court sought to protect when it admonished against impermissible hindsight reconstruction. In the present case, the Examiner's rejection is as well-supported as a house of cards. It is not and should not be sufficient for the Examiner to simply compound mere conclusory assertions of obviousness to establish a *prima facie* case. To refute a single, straightforward assertion of obviousness is difficult enough in that the applicant must prove a negative proposition. To refute two negative propositions would be almost impossible. If the Examiner's mere conclusory assertion of obviousness were sufficient on which to base a rejection, then the most subjective and weakest of all grounds for rejection becomes the most difficult to surmount.

Furthermore, as stated in *In re Fritch*, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." See *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). Thus, the mere suggestion that Jensen could be modified in the manner asserted by the Examiner, or that the Examiner is able to imagine any possible motivation or suggestion for modifying Jensen, is insufficient to

establish obviousness. The Examiner must identify a suggestion which supports the desirability of the modification of Jensen to arrive at the present invention. As the present invention is unconcerned with interrelating predefined lists of possible variables used in accident reporting to repeatedly produce consistent accident reports, and as Jensen is unconcerned with the selecting an appropriate authority based on information provided by a witness, there can be no relevant suggestion of desirability for modifying Jensen to arrive at the present invention. The present inventor, or another with ordinary skill in the art, seeking to solve the present problem, would not be motivated to modify Jensen for the reasons asserted by the Examiner. In modifying Jensen to reject the present invention, the Examiner was merely reconstructing the present invention with the benefit of the specification of the present application and impermissible hindsight.

Thus, the Examiner's asserted suggestions and motivations for modifying the teachings of the prior art references are not sufficient to establish a *prima facie* case of obviousness. Specifically, the Examiner has failed to identify a suggestion or motivation set forth anywhere in the cited references which would have caused the present inventor to consider Jensen. Furthermore, the Examiner's conclusory assertion that such suggestion or motivation would be obvious to or found in the knowledge of one with ordinary skill in the art are merely unsupported conclusions which are, without more, insufficient to establish a *prima facie* case and shift the burden to the applicant with respect to Group 1.

Similarly, on page 5, count 6, of the Office action dated March 12, 2002 and page 4, count 3, of the advisory action dated May 22, 2002, the Examiner asserts that, "it would have been obvious to one with ordinary skill in the art at the time the invention was made

to incorporate the feature above with Jensen's for the purpose of sending information to the person selected by the computer system", with respect to Group 2. As the Examiner has failed to establish a *prima facie* case of obviousness, the rejections of Groups 1 and 2 under 35 U.S.C. §103 based on Jensen cannot be sustained.

- b. *The Examiner has not identified prior art that teaches all the claim limitations of the present invention, and, therefore, has failed to establish a prima facie case of obviousness as required by 35 U.S.C. §103.*

On page 3, count 6, of the Office action dated March 12, 2002 and page 2, count 3, of the advisory action dated May 22, 2002, the Examiner acknowledged that "Jensen does not disclose the witness selects an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness". In the advisory action, the Examiner cited Horovitz.

As discussed above, Horovitz does not teach or suggest "selecting an authority ... based ... on information provided by the witness". Specifically, the prior art clearly does not teach or suggest selecting an authority based on information provided by the witness, as recited in Group 1.

On page 5, count 6, of the Office action dated March 12, 2002 and page 3, count 3, of the advisory action dated May 22, 2002, the Examiner also acknowledged that "Jensen does not disclose the authority is automatically selected by the computer system based on information entered into the incident report by the witness". In the advisory action, the Examiner cited Costin.

As discussed above, Costin teaches that “[t]he user enters ... the information by selecting ... the recipient of the document”. See column 5, lines 54-58. Specifically, the prior art clearly does not teach or suggest the authority being selected by the computer system, as recited in Group 2.

On page 5, count 6, of the Office action dated March 12, 2002 and page 4, count 3, of the advisory action dated May 22, 2002, the Examiner mistakenly states that “Jensen further discloses receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report”, with respect to Group 3. The Examiner cited figure 10, item 72 of Jensen.

On page 5 of the Request for Reconsideration, the applicant acknowledged that Jensen’s Figure 10 does show a field entitled “corrective action taken”. The applicant argued that “this is clearly meant to cover action taken by one of the witnesses in response to an incident and not action taken by the authority in response to the incident report. As stated above, Jensen teaches of filling out forms that may be submitted to an agency, such as, OSHA and tracking statistics, as stated in column 2, lines 1-10. In fact, Jensen does not teach of actually receiving an action report explaining the authority’s actions from either OSHA, DMV, or any other authority”. As shown in Jensen’s Figure 10, the corrective action taken is associated with an “accident description”. Specifically, the accident description reads “Employee’s right arm was burned when the furnace lock-out/tag-out switch failed to engage” and the corrective action taken reads “have shut down the furnace and ordered repairs made. Also, have advised employee of correct procedure”. Clearly, the corrective action taken was taken immediately, in direct response to the incident itself and not in response to the incident report. Additionally, the witness

entering the information is clearly the same person who took the corrective action and the incident report is being entered after the corrective action has been taken. Therefore, applicant argued that the prior art does not teach or suggest "receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report". Specifically, the prior art clearly does not teach or suggest the computer system receiving the action report from the authority explaining the action the authority took in response to the incident report, as recited in Group 3.

#### D. Conclusion

The Examiner's rejections of claims 1-20, Groups 1-3, under 35 U.S.C. §103 are based on unsupported Official Notice. Specifically, the Examiner has failed to cite references in support of his position. Therefore, the applicant was not "given the opportunity to challenge the correctness of such assertions". As the Examiner has failed to cite references in support of his position, the rejections based on the Official Notices cannot be sustained.

Furthermore, the Examiner has failed to establish a *prima facie* case of obviousness to support the rejections of claims 1-20, Groups 1-3, under 35 U.S.C. §103. Specifically, the Examiner has failed to identify a suggestion or motivation set forth anywhere in the cited references which would have caused the present inventor to consider Jensen. Without offering any substantive support, the Examiner relies on mere assertions that the present invention is obvious given the modification of Jensen and the suggestion or motivation for modifying Jensen is obvious given the knowledge of one with ordinary skill in the art. Additionally, the Examiner has failed to cite references that teach all claim

limitations of the present invention. As the Examiner has failed to establish a *prima facie* case of obviousness, the rejections under 35 U.S.C. §103 cannot be sustained.

Accordingly, reversal of the Examiner's rejections is proper and such favorable action is solicited.

Respectfully submitted,

By  50,570 For

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## **IX. Appendix**

Currently pending claims 1-20 read as follows.

1. A computer-based method of collecting and processing incidents observed by witnesses comprising the steps of:

receiving into a computer system an incident report directly from a witness who observed an incident committed by an offender;

prompting the witness to provide certain types of information about the incident;

selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness; and

sending the incident report to the selected authority so that the authority can respond to the incident report.

2. The method as set forth in claim 1, the incident being selected from the group consisting of a criminal act, a legal violation, a sale of a defective product, and a rendering of unsatisfactory service.

3. The method as set forth in claim 1, further including the step of prompting the witness to enter into the incident report identification information identifying the offender.

4. The method as set forth in claim 1, further including the step of receiving additional identification information identifying the offender and adding the additional identification information to the incident report.

5. The method as set forth in claim 4, the additional information being obtained by searching files accessible by the computer system based on the identification information entered by the witness.

6. The method as set forth in claim 4, the additional information being obtained by receiving the additional information from the authority based on the information entered by the witness.

7. The method as set forth in claim 1, wherein the authority is automatically selected by the computer system based on information entered into the incident report by the witness.

8. The method as set forth in claim 1, wherein the authority if selected by the witness.

9. The method as set forth in claim 1, further including the step of receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report.

10. The method as set forth in claim 9, further including the step of storing the action report along with the incident report in a file accessible by the computer system.

11. The method as set forth in claim 1, wherein the incident reports from a plurality of different witnesses are received in the computer system.

12. The method as set forth in claim 11, further including the step of storing the incident reports in a searchable database.

13. The method as set forth in claim 12, further including the step of permitting persons to access the searchable database to view the incident reports.

14. The method as set forth in claim 13, further including the step of receiving additional incident information from the persons that access the searchable database and adding the additional incident information to the incident reports to assist the authorities.

15. The method as set forth in claim 14, further including the step of sending the additional identification information to the witness.

16. The method as set forth in claim 15, further including the step of prompting the witness to update the incident report based on the additional identification information.

17. A computer-based method of collecting and processing incidents observed by witnesses comprising the steps of:

receiving into a computer system an incident report directly from a witness who observed an incident committed by an offender;

prompting the witness to enter certain types of information about the incident into the computer system, the information including identification information identifying the offender;

selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information entered by the witness; and

sending the incident report to the selected authority so that the authority can respond to the incident report.

18. The method as set forth in claim 17, wherein the authority is selected by the computer system based on information entered into the incident report by the witness.

19. The method as set forth in claim 17, further including the steps of receiving an action report from the authority explaining what action was taken in response to the incident report and allowing the witness to view the action report.

20. A computer-based method of collecting and processing incidents observed by witnesses comprising the steps of:

receiving into a computer system an incident report directly from a witness who observed an incident committed by an offender, wherein the witness does not know to whom the incident report should be sent; prompting the witness to enter certain types of information about the incident into the computer system, the information including identification information identifying the offender;

selecting an authority to whom the incident report should be sent, wherein the authority is selected by the computer system based at least in part on information entered by the witness;

sending the incident report to the selected authority so that the authority can respond to the incident report;

receiving an action report from the authority explaining what action was taken in response to the incident report; and

storing the action report in a searchable database.